

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Case No. 1617.1001CIP
(MBHB 03-622-A)

PATENT

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APR 11 2005

In re Application of:

Timothy W. Dygert

Serial No.: 09/976,038

Filed: October 15, 2001

For: Playback Device Having Text Display and
Communication with Remote Database of Titles)

Examiner: Ali, Mohammad

Art Unit: 2177

FACSIMILE TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Office of Petitions
Fax: (703) 872-9306

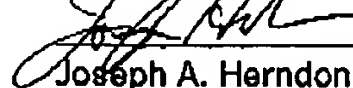
Number of Pages: 34
Including this Transmittal Letter

Sir:

In regard to the above identified application:

1. We are transmitting herewith the attached:
 - a. Request for Correction of Inventorship under 37 CFR § 1.48(a) including Exhibits A - E
2. With respect to additional fees:

<u> x </u>	A. Please charge \$260.00 to Deposit Account No. 13-2490.
<u> </u>	B. Attached is a check in the amount of \$_____.
3. Please charge any additional fees or credit overpayment to Deposit Account
No. 13-2490.
4. **CERTIFICATE OF MAILING UNDER 37 CFR § 1.8:** The undersigned hereby certifies that this Transmittal Letter and the papers, as described in paragraph 1 hereinabove, are being facsimile transmitted to the U.S. Patent and Trademark Office (Fax No. (703) 872-9306) on this 11th day of April, 2005.

By : 
Joseph A. Herndon
Reg. No. 50,469

MCDONNELL BOEHMEN,
HULBERT & BERGHOFF LLP
300 SOUTH WACKER DRIVE
CHICAGO, ILLINOIS 60606
TELEPHONE (312) 913-0001
FACSIMILE: (312) 913-0002

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Alexandria, VA 22313-1450

**REQUEST FOR CORRECTION OF
INVENTORSHIP UNDER 37 CFR § 1.48(a)**

Dear Sir:

Applicants respectfully request the following inventors to be added to this application:

Scott A. Jones of 1150 West 116th Street, Carmel, Indiana 46032; and

Douglas M. Keenan of 505 Tamarack Lane, Noblesville, Indiana 46060

The omission of Scott A. Jones and Douglas M. Keenan occurred without deceptive intent on the part of Timothy W. Dygert, Sethu K. Madhavan, Gerard V. Talatinian, Scott A. Jones, or Douglas M. Keenan.

Enclosed with this Request are:

- ☒ A statement from Scott A. Jones stating that the error in inventorship occurred without deceptive intention on his part;

- ☒ A Declaration and Power of Attorney as required by CFR § 1.63 signed by all the actual inventors except the non-signing inventor, Douglas Keenan;
- ☒ Consent of Assignee Pursuant to 37 CFR §3.73(b);
- ☒ Petition under 37 CFR §1.47(a) to make the application on behalf of the non-signing inventor, Douglas Keenan;
- ☒ A signed Declaration of Facts of Joseph A. Herndon in Support of the Petition under 37 CFR §1.47(a) together with Exhibits A-E;
- ☒ Payment in the amount of \$130.00 for the processing fee set forth in CFR § 1.17(h) for the Petition under 37 CFR § 1.47(a);
- ☒ Payment in the amount of \$130.00 for the processing fee set forth in CFR § 1.17(i) for this Request for Correction of Inventorship under 37 CFR § 1.48(a);

Respectfully submitted,

McDonnell Boehnen Hulbert & Berghoff LLP

Date: 4/11/05

By: 

Joseph A. Herndon
Reg. No. 50,469

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**In re Application of:
Timothy W. Dygert**

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**For: Playback Device Having
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**Commissioner for Patents
P.O. Box 1450
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STATEMENT FROM SCOTT A. JONES

Dear Sir:

I, Scott A. Jones, residing at 1150 West 116th Street, Carmel, Indiana 46032, hereby affirm that the error in inventorship in U.S. Patent Application Serial No. 09/976,038 occurred without deceptive intention on my part.

Respectfully Submitted,

By:

Scott A. Jones

Case No.: 1617.1001CIP
(MBHB 03-622-A)

DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled:

PLAYBACK DEVICE HAVING TEXT DISPLAY AND COMMUNICATION WITH REMOTE DATABASE OF TITLES

the specification of which was filed on October 15, 2001 and has serial number 09/976,038.

I believe the following persons to be inventors of the above-referenced application: (1) Timothy W. Dygert of Columbia City, IN, (2) Sethu K. Madhavan of ~~Indianapolis, IN~~ ^{CANTON, MI}, (3) Gerard V. Talatinian of Indianapolis, IN, (4) Scott A. Jones of Carmel, IN, and (5) Douglas M. Keenan of Noblesville, IN.

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR § 1.56.

I hereby claim foreign priority benefits under 35 U.S.C. § 119(a)-(d) or § 365(b) of any foreign application(s) for patent or inventor's certificate, or § 365(a) of any PCT international application which designated at least one country other than the United States, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application(s):

<u>Number</u>	<u>Country</u>	<u>Day/Month/Year Filed</u>
1.		

I hereby claim the benefit under 35 U.S.C. § 119(e) of any United States provisional application(s) listed below:

<u>Application Number</u>	<u>Filing Date</u>
1.	

I hereby claim the benefit under 35 U.S.C. § 120 of any United States application(s), or § 365(c) of any PCT international application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT international application in the manner provided by the first paragraph of 35 U.S.C. § 112, I acknowledge the duty to disclose information which is material to patentability as defined in 37 C.F.R. § 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

<u>Application Number</u>	<u>Filing Date</u>	<u>Status: patented, pending, abandoned</u>
1. 09/227,086	January 5, 1999	Patented (Now U.S. Patent No. 6,304,523)

I hereby appoint the practitioners associated with the Customer Number provided below to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith, and I direct that all correspondence be addressed to that Customer Number.

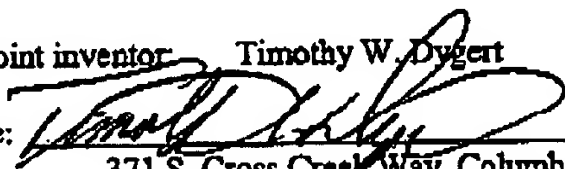
Customer Number: 020306

Principal attorney or agent: Eric Moran

Telephone number: 312-913-0001

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of first joint inventor: Timothy W. Dygert

Inventor's signature: 

Date: 8/27/04

Residence: 371 S. Cross Creek Way, Columbia City, Indiana 46725
 Citizenship: United States of America
 Post Office Address: 371 S. Cross Creek Way, Columbia City, Indiana 46725

Full name of second joint inventor: Sethu K. Madhavan

Inventor's signature: 

Date: 9/7/04

Residence: ~~2012 Sudbury Street, Naperville, Illinois 60564~~ 49121 ROCKEFELLER DR, CANTON, MI 48189
 Citizenship: India
 Post Office Address: ~~2012 Sudbury Street, Naperville, Illinois 60564~~ 49121 ROCKEFELLER DR, CANTON, MI 48189

Full name of third joint inventor: Gerard V. Talatinian

Inventor's signature: 

Date: 09/02/2004

Residence: ~~7572 Prairie View Lane, Indianapolis, Indiana 46256~~
 Citizenship: United States of America
 Post Office Address: 7572 Prairie View Lane, Indianapolis, Indiana 46256

Full name of fourth joint inventor: Scott A. Jones

Inventor's signature: 

Date: 9-19-04

Residence: 1150 West 116th Street, Carmel, Indiana 46032
 Citizenship: United States of America
 Post Office Address: 1150 West 116th Street, Carmel, Indiana 46032

Full name of fifth joint inventor: Douglas M. Keenan

Inventor's signature: _____

Date: _____

Residence: 505 Tamarack Lane, Noblesville, Indiana 46060
 Citizenship: United States of America
 Post Office Address: 505 Tamarack Lane, Noblesville, Indiana 46060

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 Alexandria, VA 22313-1450

CONSENT OF ASSIGNEE PURSUANT TO 37 CFR 3.73(b)

Dear Sir:

Digital Networks North America, Inc. (DNNA) is the assignee of U.S. Patent Application No. 09/976,038. DNNA consents to the correction of inventorship under 37 CFR § 1.48(a) for this patent application. In particular, DNNA consents to the addition of Scott A. Jones of 1150 West 116th Street, Carmel, Indiana 46032, and Douglas M. Keenan of 505 Tamarack Lane, Noblesville, Indiana 46060 to the inventorship of this patent application.

Thus, the inventorship for U.S. Patent Application No. 09/976,038 includes Tim Dygert, Sethu Madhavan, Gerard Talatinian, Scott A. Jones, and Douglas M. Keenan. An assignment executed by Tim Dygert, Sethu Madhavan, and Gerard Talatinian assigning to DNNA their entire rights to the above-referenced invention accompanies this consent. Further, Scott A. Jones and Douglas M. Keenan executed an assignment transferring their entire interest in the invention of U.S. Patent Application Serial No. 09/227,086 (the parent application to which the present

continuation-in-part application claims priority) and their entire interest in any continuation-in-part obtained for the same invention to DNNA. That assignment is recorded at reel 014462 and frame 0133.

The undersigned is authorized to act on behalf of Digital Networks North America, Inc (DNNA).

Date:

8/24/04

Respectfully submitted,

By:

David Meisels

David Meisels

General Counsel

Digital Networks North America, Inc.

PATENT

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) Group Art Unit: 2177

Serial No.: 09/976,038

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) Examiner: Ali, Mohammad

Filed: October 15, 2001

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Commissioner for Patent
P.O. Box 1450
Alexandria Virginia 22313-1450PETITION UNDER 37 C.F.R. §1.47(a)

Sir:

Because Douglas Keenan, one of the inventors for the present application, refuses to sign the oath and declaration under 37 C.F.R. § 1.63 and a Statement indicating that the error in inventorship in U.S. Patent Application Serial No. 09/976,038 occurred without deceptive intention on his part, Applicants submit this Petition Under 37 C.F.R. § 1.47(a) to make the application and the Statement on behalf of Douglas Keenan.

As proof of diligence, Applicants submit the accompanying Declaration of Joseph A. Herndon, registered patent agent and employee of McDonnell Boehnen Hulbert & Berghoff, a law firm having offices at 300 South Wacker Drive, Chicago, Illinois 60606, including its Exhibits A-E setting forth attempts to obtain the signature of the non-signing inventor.

McDonnell Boehnen
Hulbert & Berghoff LLP
300 S. Wacker Drive
Chicago, Illinois 60606
(312) 913-0001

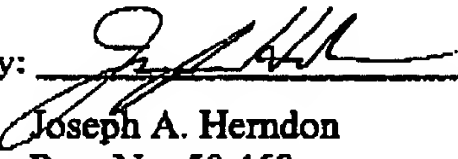
Douglas Keenan's last known address is 505 Tamarack Lane, Noblesville, Indiana 46060.

The required petition fee of \$130.00 under 37 C.F.R. §1.17(h) is enclosed herewith.

Respectfully submitted,

McDonnell Boehnen Hulbert & Berghoff LLP

Date: 4/11/05

By: 
Joseph A. Herndon
Reg. No. 50,469

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Commissioner for Patents
P.O. Box 1450
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**DECLARATION OF FACTS BY JOSEPH A. HERNDON
IN SUPPORT OF PETITION UNDER 37 C.F.R. §1.47(a)**

This Declaration of Facts is made as to the facts that are relied upon to show the diligent efforts that were made to secure the execution of the Combined Declaration and Power of Attorney and the Statement in support of the Request for Correction of Inventorship under CFR § 1.48(a) by the omitted inventor, Douglas Keenan, for the above-referenced patent application after deposit in the U.S. Patent and Trademark Office.

This Declaration of Facts is being made by an available person having first-hand knowledge of the facts recited therein.

1. I, Joseph A. Herndon, am a patent agent registered to practice before the U.S. Patent and Trademark Office: Registration No. 50,469.

McDonnell Bochen
Hulbert & Berghoff LLP
300 S. Wacker Drive
Chicago, Illinois 60606
(312) 913-0001

2. I am employed by McDonnell Boehnen Hulbert & Berghoff, a law firm having offices at 300 South Wacker Drive, Chicago, Illinois 60606.

3. On October 15, 2001, Richard A. Gollhofer, an employee of the law firm of Staas & Halsey and registered to practice before the U.S. Patent and Trademark Office, Registration No. 31,106, filed a continuation-in-part patent application (hereinafter "the present application") claiming priority to U.S. Patent Application Serial No. 09/227,086 (hereinafter "the '086 application").

4. The '086 application and the present application were transferred to the law firm of McDonnell Boehnen Hulbert & Berghoff on or about May of 2003 and Powers of Attorney by Assignee of Entire Interest and Revocation of Prior Powers for both applications is attached as Exhibit A.

5. On October 16, 2003, Mr. Eric Moran, an employee of McDonnell Boehnen Hulbert & Berghoff and a patent attorney registered to practice before the U.S. Patent and Trademark Office, Registration No. 50,967, filed a reissue patent application for U.S. Patent No. 6,304,523, entitled "Playback Device Having Text Display and Communication with Remote Database of Titles," now Application Serial No. 10/687,510 (hereinafter "the reissue patent application") at the request of Escient, a Delaware corporation, having a place of business at 2841 Mission College Boulevard, Santa Clara, California 95054.

6. The reissue patent application was filed without a signed Declaration and Power of Attorney.

7. On May 28, 2004, I sent a package via United States Postal Service Express Mail to Mr. Keenan (one of the named inventors of the reissue patent application) at 505 Tamarack Lane, Noblesville, Indiana 46060. The package contained copies of the reissue patent application, a Declaration and Power of Attorney for the reissue patent application, a cover letter asking Mr. Keenan to sign and return the Declaration and Power of Attorney for the reissue patent application, along with a pre-paid and pre-addressed return Fed Ex envelope addressed to me at the Offices of McDonnell Boenhen Hulbert & Berghoff. A copy of the letter is attached as Exhibit B.

8. On June 9, 2004, I sent a second package via United States Postal Service Express Mail to Mr. Keenan at 505 Tamarack Lane, Noblesville, Indiana 46060. The package contained a second set of copies of the reissue patent application, a Declaration and Power of Attorney for the reissue patent application, a cover letter asking Mr. Keenan to sign and return the documents, along with a pre-paid and pre-addressed return Fed Ex envelope addressed to me at the Offices of McDonnell Boenhen Hulbert & Berghoff. A copy of the letter is attached as Exhibit C.

9. During the weeks of May 24, 2004, May 31, 2004, June 7, 2004, June 14, 2004, and June 21, 2004, I called Mr. Keenan at (317) 776-1144 and (317) 776-1404 (e.g., phone numbers discovered from a white pages telephone search) and left several voicemails requesting that he call me at the Offices of McDonnell Boenhen Hulbert & Berghoff.

10. On June 23, 2004, I received an envelope containing a letter and another envelope containing another letter. A copy of both envelopes and both letters are attached as Exhibit D. As shown, the letters were written by Douglas Keenan and indicate that he has no interest in signing anything for the reissue patent application.

11. On March 23, 2005, I performed a white pages search to determine the current address of Douglas Keenan. The search returned the same address: 505 Tamarack Lane, Noblesville, Indiana 46060.


12. On March 23, 2005, I sent another package via Federal Express Mail to Mr. Keenan at 505 Tamarack Lane, Noblesville, Indiana 46060. The package contained a set of copies of the present patent application, a Declaration and Power of Attorney for the present patent application, a cover letter asking Mr. Keenan to sign and return the documents, along with a pre-paid and pre-addressed return Federal Express envelope addressed to me at the Offices of McDonnell Boehnen Hulbert & Berghoff. A copy of the letter is attached as Exhibit E.

13. On April 1, the March 23, 2005 letter was returned as an undeliverable package in that Doug Keenan no longer lives at that address.

14. As of this date, we have not received a reply from Mr. Keenan regarding the Declaration and Power of Attorney for the present application.

I hereby declare that all statements made herein to the best of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful statements may jeopardize the validity of the application or any patent issued thereon.

Dated: 4/11/05

By: 
Joseph A. Herndon
Reg. No. 50,469
Patent Agent
McDonnell Boehnen Hulbert & Berghoff
300 South Wacker Drive
Chicago, Illinois 60606
Telephone: 312-913-0001
Facsimile: 312-913-0002